

REMARKS

INTRODUCTION

Claims 1, 4-6, 8-11, 15-17, 19-24, 26, and 35 are currently pending. Reconsideration as to the patentability of the pending claims is requested in light of the following.

OBJECTION TO THE SPECIFICATION

The specification has been objected to due to an informality. This informality has been corrected in accordance with the Examiner's suggestion. Withdrawal of the objection to the specification is therefore respectfully requested.

REJECTION OF CLAIMS 1, 4, 11, 17, 26 and 35 UNDER 35 U.S.C. §103(a)

Claims 1, 4, 11, 17, 26, and 35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,285,383 to Lindsey et al. (Lindsey) in view of U. S. Patent No. 5,950,178 to Borgato (Borgato) further in view of U.S. Patent No. 5,168,446 (Wiseman).

Applicant initially disputes the "final" status of this rejection. While the Final Office Action asserts that the amendments to the claims made in the response to the prior Office Action of October 23, 2002 necessitated the new ground of rejection, it is submitted that this is not the case since all of the claim limitations in the amended claims were present in the original claim set (either in an original independent claim or in an original dependent claim), and the Wiseman reference (while of record) was explicitly **not** relied upon in the first Office Action. See Office Action of October 23, 2002, paragraph 10. Respectfully, it appears that with the benefit of further review of the claimed subject matter, the Examiner has elected to apply an additional reference due to the arguments (as opposed to the amendments) presented in the earlier response indicating why the combined Lindsey and Borgato references failed to render obvious this subject matter. In this regard, since the MPEP states that a rejection should not be considered final when a new ground of rejection is asserted that is not necessitated by Applicant's amendment to the claims (MPEP §706.07(a)),

withdrawal of the finality of the obviousness rejection of claims 1, 4, 11, 17, 26, and 35 is therefore requested.

Notwithstanding the discussion above, it is submitted that the references relied upon do not render obvious the claimed subject matter.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 1 recites a system for utilizing at least one tender that includes, *inter alia*, a processing device transmitting information corresponding to the data, wherein the at least one tender is provided for a complex multi-variable commodity, the processing device further enabling a user to request an exception to create or modify a term of the at least one tender, wherein the complex multi-variable commodity is a particular commodity whose price determination is based on a variation of a plurality of variable characteristics regarding a physical characteristic of the particular commodity.

In the Final Office Action, it is stated that Wiseman discloses a processing device that enables a user to request an exception to create or modify a term of the at least one tender. It is submitted that neither the particular cited sections relied upon, nor the Wiseman reference as a whole, disclose this feature. While the Wiseman reference discloses a currency trading system in which a counterparty can modify a proposed quote or a trading party may elect to negotiate with a

counterparty, this is not equivalent to what is claimed because the proposals and quotes disclosed in Wiseman are not tenders.

In Wiseman, the interaction between the trading party and the counterparty is a closed two-party transaction, in which any modifications made apply solely to the transaction being negotiated; the transaction does not constitute a tender in a multiparty auction environment. In contrast, in the exception requesting process according to the present invention, the tender offer is made to multiple parties and although an exception request is initiated by a single counterparty, upon acceptance it becomes linked to the tender offer and thus applies to any party in receipt of the tender. In this regard, the specification explains as follows:

If the exception is accepted, such exception is then posted as a part of the tender in steps 413, 514. Once the exception request has been transmitted, and the exception has either been accepted or rejected (in steps 412, 513), the tender details are again presented to all designated tender recipients with all the accepted exceptions 414, 515.

(Specification, page 18, lines 5-8; emphasis added).

As indicated in the above-quoted passage, the exception becomes part of the tender and is made to all of the tender recipients in a multiparty environment. This exception process is crucial particularly during transactions involving complex, multivariable commodities in which recipients may be willing to pay a premium over a quoted price for a particular grade or type of the commodity being tendered. (See e.g., Specification, page 7, lines 5-16). Such considerations do not apply in the currency trading system disclosed in Wiseman, since currencies are not complex, multivariable commodities having differing types, grades and conditions.

It is accordingly submitted that Wiseman does not disclose or suggest a processing device further enabling a user to request an exception to create or modify a term of the at least one tender as claimed, and that therefore, the combination of Lindsey, Borgato and Wiseman fails to disclose or suggest each of the recited elements of claim 1. It is submitted that claim 1 and its dependent claim 4 are therefore patentable over the references relied upon.

As independent claims 11, 17, 26 and 35 recite features analogous to the features discussed above with respect to claim 1, it is submitted that these claims are also patentable over the references relied upon.

Withdrawal of the rejection of claims 1, 4, 11, 17, 26, and 35 under 35 U.S.C. §103(a) is therefore respectfully requested.

REJECTION OF CLAIMS 5, 6, 8-10, 15, 16, 19-24, 28 and 29 UNDER 35 U.S.C.

§103(a)

Claims 5, 6, 8-10, 15, 16, 19-24, 28 and 29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lindsey in view of Borgato (Borgato).

It is noted that each of claims 5, 6, 8-10 depends from independent claim 1, claims 15 and 16 depend from independent claim 11, claims 19-24 depend from independent claim 17 and claims 28 and 29 depend from independent claim 26. Accordingly each of claims 5, 6, 8-10, 15, 16, 19-24, 28 and 29 incorporates the features of the respective independent claim from which it depends. While the rejection of the independent claims addressed above relied upon a combination of three references (Lindsey, Borgato and Wiseman) the rejection of their dependent claims relies on fewer (two) references (Lindsey and Borgato). Applicant initially respectfully questions how a rejection of dependent claims under §103(a) can rely on fewer references than are required in asserting a rejection toward the claims from which they depend. The Final Office Action has asserted that the Wiseman reference cures the deficiencies of the primary Lindsey and Borgato references with respect to the independent claims (which reliance was addressed and disputed in the discussion above). These deficiencies of the primary references therefore remain in the context of the dependent claims.

Notwithstanding the above, it is submitted that the combination of Lindsey and Borgato fails to render obvious each of the features of the independent claims at least because neither of these references discloses or suggests a system or method in which a user requests an exception to create or modify a term of at least one tender, as discussed above and in the previously-submitted response to the Office Action of October 23, 2002.

It is accordingly submitted that claims 5, 6, 8-10, 15, 16, 19-24, 28 and 29 are patentable over the references relied upon.

Withdrawal of the rejection of claims 5, 6, 8-10, 15, 16, 19-24, 28 and 29 under 35 U.S.C. §103(a) is therefore respectfully requested.

CONCLUSION

It is respectfully submitted that the foregoing amendments and remarks demonstrate that the application is in clear condition for allowance and prompt notification thereof is solicited. The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON

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